

REMARKS/ARGUMENTS

Applicant submits this response to the Office Action dated December 3, 2008. Claims 1 – 10 are pending in this application.

I. Oath and Declaration

In the Office Action dated December 3, 2008, the Examiner rejected claims 1 – 10 under 35 U.S.C. § 251 because of a defective oath and declaration. Applicant has included herewith a revised reissue application declaration by the inventor, a revised reissue application declaration by the assignee, and a supplemental declaration for reissue patent application to correct “errors” statement. Applicant avers that these documents comply with 37 C.F.R. § 1.175.

II. Recapture

The Examiner has also rejected Claim 10 under 35 U.S.C. § 251 for improperly recapturing subject matter surrendered during the initial prosecution. Applicant respectfully disagrees and shows the following. In the first (and only) Office Action in the parent application, dated December 18, 2000, the Examiner indicated that Claim 10 contained allowable subject matter and would be allowed if it was written to include all the limitations of the claims on which it depended. Therefore, the amendment to Claim 10 was not made to overcome the prior art; rather, Claim 10 was simply re-written into independent form. Thus, Applicant did not surrender subject matter merely by the fact that he amended Claim 10 to place it into independent form.

A. Recapture Analysis: First step

Furthermore, in a recapture analysis, the language of the claims in the reissue application are compared with claims in the original application that were cancelled or amended to overcome the prior art. As outlined in MPEP § 1412.02 (C), “First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution to define over the art.” (emphasis added). Thus, during recapture analysis, the Examiner should start by comparing Claim 10 to those claims in the original application that were cancelled or amended to define over the prior art.¹

The only claims in the original application that were cancelled or amended in response to the prior art were original claims 1, 7, 9, and 11 – 15. (Note that some of the claims were rearranged and re-numbered when the patent issued such that these numbers do not correspond to the current claim numbers.) During recapture analysis, therefore, the Examiner should begin by comparing the current language of amended Claim 10 with the original language of original claims 1, 7, 9, and 11 – 15. In this step of the analysis, improper recapture only results if the

¹ The Examiner states on page 3 of the current Office Action that “Claim 10 cancels limitations to – a series of longitudinally extending lands and crests – as had been inserted by amendment within claim 1 during prosecution” The Examiner is presumably referring to original claim 8 (which issued as claim 1 in the patent). As outlined below, original claim 8 was never rejected over the prior art. Rather, it was merely objected to and subsequently re-written into independent form. As such, no subject matter was surrendered when original claim 8 was re-written into independent form and it is improper to compare the current language of Claim 10 to original claim 8. Furthermore, the Examiner is factually incorrect; no limitation was added to original claim 8 when it was re-written into independent form. Thus, Applicant never inserted (or even argued or relied upon) a limitation related to “a series of longitudinally extending lands and crests” to obtain allowance of original claim 8.

current language of Claim 10 is “as broad or broader in scope” than the original language of one of these cancelled / amended claims. MPEP § 1412.02 (C).

Comparing current Claim 10 to original claim 1, it is clear that current Claim 10 recites a surface tread that was not recited in original claim 1. Thus, current Claim 10 is not as broad or broader than original claim 1 and thus has not recaptured subject matter. (It is immaterial to the recapture analysis whether the lands and crests of the surface tread are “longitudinally extending” or not. The fact that Applicant’s amended Claim 10 recites a “surface tread” makes Applicant’s amended Claim 10 narrower than original claim 1.)

Comparing current Claim 10 to original claim 7, it is similarly clear that current Claim 10 recites a surface tread that was not recited in original claim 7. Thus, for the same reasons, there has been no recapture vis-à-vis original claim 7.

Comparing current Claim 10 to original claim 9, it is again clear that current Claim 10 recites a surface tread that was not recited in original claim 9.

Finally, comparing current Claim 10 to original claims 11 – 15, it is clear that current Claim 10 is directed towards a “decking system” whereas original claims 11 – 15 were directed towards “construction elements.” Furthermore, current Claim 10 recites a surface tread that was not recited in original claims 11 – 15.

B. Recapture Analysis: Second step

As outlined in MPEP § 1412.02 (C), “Second, it must be determined whether the reissue claim omits or broadens any limitation that was added/argued during the original prosecution to overcome an art rejection.” Once again, the Examiner should only look to limitations that were

added / argued to overcome an art rejection. Because only original claims 1, 7, 9, and 11-15 were rejected over the prior art, the Examiner should only look at limitations that were added (or argued) to those claims during prosecution. A review of the file history shows that original claims 1, 7, 9, 11, and 12 were cancelled (with no further comment) in response to the Dec. 18, 2000 Office Action in the parent case. Thus, with respect to original claims 1, 7, 9, 11, and 12, there were no limitations that were added (or argued) to overcome a prior art rejection. Importantly, no limitation reciting a surface tread (whether longitudinally extending or not) was added or argued to overcome a prior art rejection in original claims 1, 7, 9, 11, or 12. Thus, Applicant is not prohibited from broadening his limitation in current Claim 10 relating to the surface tread on account of any arguments / amendments related to original claims 1, 7, 9, 11, or 12.

Finally, with respect to original claims 13 – 15, these claims were indeed amended to overcome the prior art. Any narrowing of the limitations added to original claims 13 – 15 would therefore be improper recapture. However, current Claim 10 is completely different from original claims 13 – 15. Moreover, no limitation regarding a surface tread was added (or argued) to original claims 13 – 15. Therefore, Applicant is not precluded from broadening his claim limitation regarding the surface tread.

In summary, Applicant never added or argued a limitation related to a “surface tread” (whether longitudinally extending or not) in regard to any claim. Applicant merely re-wrote original claims 8 and 10 into independent form (which subsequently issued as claims 1 and 10, respectively.) Therefore, Applicant never surrendered any subject matter related to a surface tread.


III. Conclusion

In conclusion, Applicant submits that the application is in condition for allowance and earnestly requests same.

If any additional fees are due in connection with the filing of this paper or the accompanying papers, such as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to SGR Deposit Account No. 02-4300, Order No. 043850.016. If an additional extension of time under 37 C.F.R. § 1.136 is necessary that is not accounted for in the papers filed herewith, such an extension is requested. The additional extension fee also should be charged to SGR Deposit Account No. 02-4300, Order No. 043850.016. Any overpayment can be credited to Deposit Account No. 02-4300, Order No. 043850.016.

Respectfully submitted,

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